

REMARKS

Claims 1-6 and 8-13 are pending in the present application.

Claims 1, 2, 6, 8 and 12-13 are amended to more particularly point out and clearly define the invention.

Claim 6 is also amended to correct 2 typographical errors. Claim 6 is amended in line 2 to recite “treating a resin base...” instead of “treating a process wherein...” Claim 6 was also amended to recite 10^{12} to 10^{17} ($1/\square\text{ cm}$). Support in the specification is at page 5, paragraph 009.

Claims 1-6 and 8-13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. 3,642,584 to Quinn et al. Applicants respectfully traverse this rejection.

Quinn et al. (Quinn) do not teach or suggest a non-charging resin composite material in which a component comprising a metal, metal alloy, metal compound, or mixtures thereof is present at a surface of a resin base, said non-charging resin composite material having a ratio of a surface resistance of said non-charging resin composite material to a resistivity of said component containing metal, metal alloy, metal compound or mixtures thereof of 10^{12} to 10^{17} ($1/\square\text{ cm}$) (see claims 1 and 6). Quinn fails to teach or suggest all of the limitations of the claims. See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

The Final Rejection admits that Quinn does not teach the desired level of conductivity. Further, Quinn does not even suggest the desirability of a particular ratio of a surface resistance of a non-charging resin composite material to a resistivity of a component containing metal, let alone a ratio of 10^{12} to 10^{17} ($1/\square\text{ cm}$) as recited in present claims 1 and 6. Quinn must suggest the desirability of the ratios recited in present claims 1 and 6. See *In re Gordan*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). Quinn is totally silent on such ratios and the desirability of making a non-charging resin composite having such ratios. Moreover, the Final Rejection has not cited any part of Quinn which would provide support for an argument that Quinn suggests the desirability of making a non-charging resin composite having ratios of claims 1 and 6. The teachings and

suggestions of making a non-charging resin component with the recited ratios of claims 1 and 6 must come from Quinn, not Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

Further, Quinn fails to teach or suggest the surface resistance of the non-charging resin composite material as recited in present claims 2 and 8. Quinn is totally silent on surface resistance, let alone surface resistance of a non-charging resin composite of $10^6\text{-}10^{11}\Omega/\square$. Quinn only discloses bulk resistance, not surface resistance. They are not the same. See enclosed ESD Journal™ "Ohms Per Square What!" and Bridge Technology "Four-Point-Probes". No where does Quinn suggest the desirability of providing a non-charging resin composite having a specific surface resistance, let alone a surface resistance of $10^6\text{-}10^{11}\Omega/\square$. See *In re Gordan*, 733 F.2d at 902, 221 U.S.P.Q. at 1127. The Final Rejection must base an obviousness rejection on what the applied document teaches or suggests, not Applicants' disclosure. See *In re Vaeck*, 947 F.2d at 493, 20 U.S.P.Q.2d at 1442.

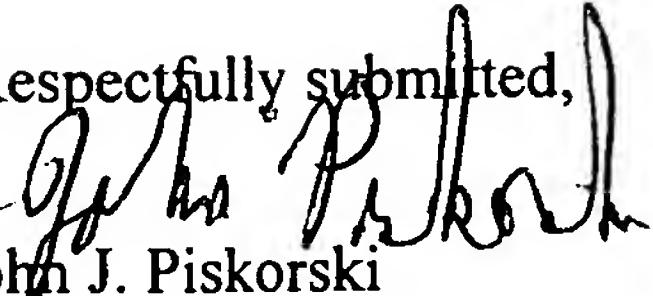
The Final Rejection has failed to present a *prima facie* case of obviousness for the above reasons. The Final Rejection has not provided any documentation which teaches or suggests at least the recited ratios of claims 1 and 6 or the surface resistance of claims 2 and 8. The U.S. Patent Office can not remedy deficiencies in the applied document and negate patentability on what it asserts as general knowledge without providing documentation that such knowledge is known. The failure to do this is not consistent with either effective administrative procedure or effective judicial review. See *In re Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Accordingly, the presently claimed invention is patentable over Quinn.

Applicants respectfully request withdrawal of the rejection of claims 1-6 and 8-13 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. 3,642,584 to Quinn et al.

Favorable consideration and allowance of claims 1-6 and 8-13 are earnestly solicited.

If the Examiner has any questions concerning this response or this application, or if he believes this application is for any reason not yet in condition for allowance, he is respectfully requested to telephone the undersigned at the number set forth below in order to expedite allowance of this application.

Respectfully submitted,


John J. Piskorski
Attorney for Applicant
Registration No. 35,647

Rohm and Haas Electronic Materials, LLC
455 Forrest Street
Marlborough, MA 01752
Telephone No.: (508) 229-7662
Facsimile No.: (508) 787-4730